UNITED STATES PATENT AND TRADEMARK OFFICE

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10/660,337	09/11/2003	Leslie Mark Ernest	AUS920030409US1	5985

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Darcell Walker
Suite 250
9301 Southwest Freeway
Houston, TX 77074

EXAMINER
BUI, BRYAN P

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _11 September 2003_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under _Ex parte Quayle_, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-27_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-27_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _09/11/2003_ is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   This communication is responsive to Application No. 10/660337 filed on

09/11/2003 in which claims 1-28 and Figures 1-7 are presented for examination.

Status of Claims

Claims 1-28 are pending of which claim 26 is missing.

Claims 1, 8, 15 and 21 are independent claims.

Renumbered claims 1-27 are rejected for the reasons discussed in detail below.

Drawings

2.   The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because

of the followings:

. Element (34) has been used to designate both a LOCAL NETWORK AREA (in

Figure 2) and a Text Section (in Figure 3a);

. Element (37) has been used to designate both a storage device (in Figure 2)

and a ATTACH icon (in Figure 3b);

. Elements (34) and (22) in Figure 2 have both been used to designate LOCAL

AREA NETWORK.

The drawings are further objected to as failing to comply with 37 CFR 1.84(p)(5)

because they do not include the following reference sign(s) mentioned in the

description: element 21 (Local Area Network) in Figure 2 and element 40 (CANCEL icon) in Figure 3b.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3.   The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: "*A Method and A Computer Program Product stored in A Computer Readable Medium for Managing Locally Initiated Electronic Mail Attachment Documents*".

Claim Objections

4.   The numbering of claims is improper because claim 26 is missing. Applicant is

required to renumber the claims in the appropriate order.

The numbering of claims is not in accordance with 37 CFR 1.126 which requires

the original numbering of the claims to be preserved throughout the prosecution. When

claims are canceled, the remaining claims must not be renumbered. When new claims

are presented, they must be numbered consecutively beginning with the number next

following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 27-28 have been renumbered into 26-27 respectively. Thus,

renumbered claims 1-27 are now pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 1-7 and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Jones et al. (US Patent Application Publication No. 2002/0120678 A1) in view of

Malik (US Pat No. 7,003,551 B2).

Regarding claim 1, Jones et al. teaches a method for managing the storage of

attachments for electronic mail messages comprising the steps of:

A) "receiving an electronic mail message at a destination" as [A method, in a first

client device, for managing client local storage comprising: sending a database file to

the server for storage, and *receiving* the database file from the server upon a

determination that the database file is to be stored in the client local storage, and stores

the database file in the client local storage] (see Jones, claim 10). Examiner notes that

"the database file" is one of an email attachment and a specification document as cited

in Jones' claim 11; and

B) "determining the origin of an attachment to the electronic message" as [A

method for managing client local storage comprising identifying a database file to be

stored in storage on a first client device] (see Jones' claim 1);

However, Jones et al. does not fully disclose the following claimed features:

C) "deleting an attachment that originated at the destination location of the

electronic message"; and

D) "creating a link to the original document located at the destination location of

the electronic message".

Malik, from the same or similar field of endeavors, discloses:

as per C), "deleting an attachment that originated at the destination location of the

electronic message" as [The mail store then removes duplicate attachment files from

email communications] (see Malik, column 3, lines 23-24) ; and

as per D), "creating a link to the original document located at the destination

location of the electronic message" as [creates links from received e-mail

communications to the corresponding attachment files in the mail store] (see Malik,

column 3, lines 24-26 together with Figure 3, step (40) and (44)).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Jones' method by adding the teachings of Malik to achieve the claimed feature of "deleting an attachment that originated at the destination location of the electronic message", and "creating a link to the original document located at the destination location of the electronic message". Such combination would have permitted Malik's method to allow Jones' method to minimize the number of duplicate copies of common attachment files to email communications that are stored in the mail store of an email server (see Malik's Abstract).

Regarding claim 2, Jones et al. discloses the claimed feature of "the destination location of the electronic message is the location of the sender of the electronic message" as [a client devices comprising an interface that sends a database file to the server for storage, and receives the database file from the server upon a determination that the database file is to be stored in the client local storage, wherein the database file is one of an email attachment an a specifications document] (see Jones' claims 22, 23).

Most of the limitations of this claim have been noted in the rejection of claim 1. Thus, it is rejected under same rationale as claim 1 (see the rejection of claim 1).

Regarding claim 3, Jones does not expressly disclose the claimed feature of "further comprising before said origin determination step the step of determining

whether the received electronic message has an attachment". Malik, from the same or

similar field of endeavors, discloses the MTA server determines whether an attachment

file is included in the email communication (see Malik, Figure 3 step (32)). Thus, it

would have been obvious to one of ordinary skill in the art at the time the invention was

made to modify Jones' method by adding the teachings of Malik to achieve the claimed

feature of "the step of determining whether the received electronic message has an

attachment". Such combination would have permitted Malik's method to allow Jones'

method to minimize the number of duplicate copies of common attachment files to email

communications that are stored in the mail store of an email server (see Malik's

Abstract).

Regarding claim 4, Jones does not expressly discloses the claimed feature of

"further comprising after said attachment deleting step, the step of saving the electronic

message". Malik, from the same or similar field of endeavors, discloses the email

message may be stored in any conventional manner in the mail store (see Malik,

column 4, lines 38-39). Thus, it would have been obvious to one of ordinary skill in the

art at the time the invention was made to modify Jones' method by adding the teachings

of Malik to achieve the claimed feature of "the step of saving the electronic message".

Such combination would have permitted Malik's method to allow Jones' method to

minimize the number of duplicate copies of common attachment files to email

communications that are stored in the mail store of an email server (see Malik's

Abstract).

Regarding claim 5, Jones discloses the claimed feature of "said attachment origin determination step further comprises determining whether the attachment was created at the location of the sender of the electronic message" as a method for managing client local storage comprising receiving a message including an attachment file from a first client device and determining whether the attachment file is to be stored locally (see Jones' claim 5). Most of the limitations of this claim have been noted in the rejection of claim 1. Thus, it is rejected under same rationale as claim 1 (see the rejection of claim 1).

Regarding claim 6, Jones does not expressly disclose the claimed feature of "further comprising before said link creation step, the step of updating the received message to reflect the deleted attachment". Malik, from the same or similar field of endeavors, discloses the links in the record of the other, previously stored email communication associated with the attachment file is modified to reflect the change in storage location (see Malik, column 5, lines 58-61 together with Figure 3 step (43)). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Jones' method by adding the teachings of Malik to achieve the claimed feature of "the step of saving the electronic message". Such combination would have permitted Malik's method to allow Jones' method to minimize the number of duplicate copies of common attachment files to email communications that are stored in the mail store of an email server (see Malik's Abstract).

Regarding claim 7, Jones discloses the claimed feature of "further comprising

before said attachment origin determination step, the step of determining whether the

recipient of an electronic message desires to save the electronic message" as client

device comprising an interface that can be used to store the database file (i.e. an email

attachment and a specifications document) (see Jones' claims 22 and 23).Most of the

limitations of this claim have been noted in the rejection of claim 1. Thus, it is rejected

under same rationale as claim 1 (see the rejection of claim 1).

Regarding claim 15, all the limitations of this claim have been noted in the

rejection of claim 1. Thus, it is rejected for the same rationale as claim 1.

Regarding claim 16, all the limitations of this claim have been noted in the

rejection of claim 3. Thus, it is rejected for the same rationale as claim 3.

Regarding claim 17, all the limitations of this claim have been noted in the

rejection of claim 4. Thus, it is rejected for the same rationale as claim 4.

Regarding claim 18, all the limitations of this claim have been noted in the

rejection of claim 5. Thus, it is rejected for the same rationale as claim 5.

Regarding claim 19, all the limitations of this claim have been noted in the

rejection of claim 6. Thus, it is rejected for the same rationale as claim 6.

Regarding claim 20, all the limitations of this claim have been noted in the

rejection of claim 7. Thus, it is rejected for the same rationale as claim 7.

6.   Claims 8-14 and 21-25, 27, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. (US Patent Application Publication No. 2002/0120678 A1) in view of Malik (US Patent No. 7,003,551 B2) as applied to claims 1-7 above, and further in view of Dunn (US Patent Publication Application No. 2004/0034688 A1).

Regarding to claims 8 and 9, most of the limitations of those claims have been noted in the rejection of claim 1. However, neither Jones et al. nor Malik discloses the claimed features of "determining whether the electronic mail recipient desires to modify an attachment that originated at the destination location of the electronic message"(as in claim 8) and "further comprising after said modification determination step, the step of modifying the attachment"(as in claim 9). Dunn, from the same or similar field of endeavors, discloses when users desire to modify, forward, resend, etc., the attachment, links to the attachment are provided with an email message (see Dunn, the Abstract). Dunn further teaches that an access interface is provided to allow a recipient of a link to a document to view and otherwise obtain the document and to perform operations on the document (see Dunn, also the Abstract). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify Jones' method (see the previous modification in rejection of claim 1) by adding the teachings of Dunn to achieve the claimed features of "determining whether the electronic mail recipient desires to modify an attachment that originated at the

destination location of the electronic message"(in claim 8) and "further comprising after

said modification determination step, the step of modifying the attachment"(as in claim

9). Such combination would have permitted Dunn's method to allow Jones and Malik'

method to avoid the problems or undesirable effects which can exist in email system

due to proliferation of multiple copies of email attachment, lack of attachment

management options or other causes (see Dunn, paragraph [0013]).

Regarding claim 10, Jones does not expressly disclose the claimed feature of

"further comprising before said origin determination step the step of determining

whether the received electronic message has an attachment". Malik, from the same or

similar field of endeavors, discloses the MTA server determines whether an attachment

file is included in the email communication (see Malik, Figure 3 step (32)). Thus, it

would have been obvious to one of ordinary skill in the art at the time the invention was

made to modify Jones' method by adding the teachings of Malik to achieve the claimed

feature of "the step of determining whether the received electronic message has an

attachment". Such combination would have permitted Malik's method to allow Jones'

method to minimize the number of duplicate copies of common attachment files to email

communications that are stored in the mail store of an email server (see Malik's

Abstract). Most of the limitations of this claim have been noted in the rejection of claim

8. Thus, it is rejected under same rationale as claim 8.

Regarding claim 11, neither Jones et al. nor Malik discloses the claimed feature

of "further comprising after said modification determination step, the step of deleting the attachment when there is a determination that the recipient does not want to modify the attachment". Dunn, from the same or similar field of endeavors, teaches that a sender can update or delete an attachment if there was a mistake in attaching the wrong object (see Dunn, paragraph [0049]).Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify Jones' method (see the previous modification in rejection of claim 1) by adding the teachings of Dunn to achieve the claimed feature of "further comprising before said link creation step, the step of updating the received message to reflect the modified attachment". Such combination would have permitted Dunn's method to allow Jones and Malik' method to avoid the problems or undesirable effects which can exist in email system due to proliferation of multiple copies of email attachment, lack of attachment management options or other causes (see Dunn, paragraph [0013]).

Regarding claim 12, Jones discloses the claimed feature of "said attachment origin determination step further comprises determining whether the attachment was created at the location of the sender of the electronic message" as a method for managing client local storage comprising receiving a message including an attachment file from a first client device and determining whether the attachment file is to be stored locally (see Jones' claim 5). Most of the limitations of this claim have been noted in the rejection of claim 8. Thus, it is rejected under same rationale as claim 8.

Regarding claim 13, neither Jones et al. nor Malik discloses the claimed feature

of "further comprising before said link creation step, the step of updating the received

message to reflect the modified attachment". Dunn, from the same or similar field of

endeavors, teaches that although a local copy of Doc1 must be obtained at client2, at

some point, such as upon saving a modified version of the document, eventually the

server's copy of Doc1 is updated to a newer version (see Dunn, paragraph [0045]).

Dunn further discloses prior email messages that referenced an older version of the

single copy are updated so that they point to the latest version (see Dunn, paragraph

[0047]). Thus, it would have been obvious to one of ordinary skill in the art at the time

the invention was made to further modify Jones' method (see the previous modification

in rejection of claim 1) by adding the teachings of Dunn to achieve the claimed feature

of "further comprising before said link creation step, the step of updating the received

message to reflect the modified attachment". Such combination would have permitted

Dunn's method to allow Jones and Malik' method to avoid the problems or undesirable

effects which can exist in email system due to proliferation of multiple copies of email

attachment, lack of attachment management options or other causes (see Dunn,

paragraph [0013]).

Regarding claim 14, Jones discloses the claimed feature of "further comprising

before said attachment origin determination step, the step of determining whether the

recipient of an electronic message desires to save the electronic message" as client device comprising an interface that can be used to store the database file (i.e. an email attachment and a specifications document) (see Jones' claims 22 and 23).Most of the limitations of this claim have been noted in the rejection of claim 8. Thus, it is rejected under same rationale as claim 8.

Regarding claim 21, all the limitations of this claim have been noted in the rejection of claim 8. Thus, it is rejected for the same rationale as claim 8.

Regarding claim 22, all the limitations of this claim have been noted in the rejection of claim 9. Thus, it is rejected for the same rationale as claim 9.

Regarding claims 23, all the limitations of those claims have been noted in the rejection of claim 10. Thus, it is rejected for the same rationale as claim 10.

Regarding claim 24, all the limitations of this claim have been noted in the rejection of claim 11. Thus, it is rejected for the same rationale as claim 11.

Regarding claim 25, all the limitations of this claim have been noted in the rejection of claim 12. Thus, it is rejected for the same rationale as claim 12.

Regarding renumbered claim 26, all the limitations of this claim have been noted in the rejection of claim 13. Thus, it is rejected for the same rationale as claim 13.

Regarding renumbered claim 27, all the limitations of this claim have been noted in the rejection of claim 14. Thus, it is rejected for the same rationale as claim 14.

Conclusion

7.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

        Arnold (US Pat No. 6,275,848 B1)

        Prahlad et al. (US Pat No. 7,155,481 B2)

        Marchionda (US Pat No. 6,628,306 A1)

        Redpath (US Pat No. 6,256,672 B1)

         Ramaley et al. (US Pat No. 6,687,741 B1)

         Kawanaka (US Pat No. 6,351,763 B1)

        Devos (US Pat No. 7,251,680 B2)

        Lin et al.(US PGPub No. 2003/0005065 A1)

        Tada et al. (US PGPub No. 2003/0041112 A1)

        Moss (US PGPub No. 2002/0198944 A1)

8.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Bryan Bui whose telephone number is (571)-270-

1981.The examiner can normally be reached on Monday-Friday from 7:30 am to 5:00

pm (EST). If attempts to reach the examiner by telephone are unsuccessful, the

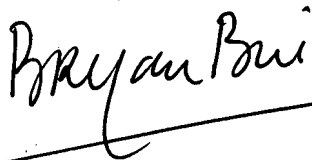examiner's supervisor, Frantz Coby can be reached on (571)-272-4017. The fax phone

number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pairdirect. uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from USPTO Customer Service Representative or access to the automated information system, call 1-(800)-786-9199 (in U.S.A or Canada) or 1-(571)-272-1000.

FRANTZ COBY
SUPERVISORY PATENT EXAMINER

Examiner

Bryan P. Bui